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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,061	09/26/2003	Jennifer Chamblee	020375-038600US	1241
20350 7590 06/06/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER HAGEMAN, MARK	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 06/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/673,061	<b>Applicant(s)</b> CHAMBLEE ET AL.	
	<b>Examiner</b> Mark Hageman	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,219,994 to Taniguchi in view of US 6,801,833 to Pintsov et al. Taniguchi discloses a plurality of trays (41) that are each adapted to hold a plurality of mail items; a plurality of mail processing machines that are adapted to process the mail items (42, 43), through any of a plurality of distinct processing paths through the plurality of mail processing machines (figure 3). Taniguchi does not disclose a tray tag generator that is configured to produce tray tags wherein each of the plurality of trays is associated with a tray tag, wherein each tray tag includes recipient information identifying processing requirements relating to the recipient of the mail items in the tray associated with the tray tag, a plurality of tray tags, wherein each tray is associated with a tray tag that includes recipient information identifying processing requirements relating to the recipient of the mail items in the tray associated with the tray tag; and a process management system that is configured to receive processing status information relating to the trays and output the information upon request, readers such as bar code and emissive tag readers for reading the information from the tray tags and obtaining the process status

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information by reading information from tray tags. The language "wherein the mail items are addressed to a common recipient," in claims 1 and 5 is not given patentable weight as this limitation is directed to the material being worked upon. As set forth in MPEP 2115 "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim."

Pintsov discloses disclose a tray tag generator that is configured to produce tray tags (col. 3, lines 31+), wherein each of the plurality of trays is associated with a tray tag (28), wherein each tray tag includes recipient information identifying processing requirements relating to the recipient of the mail items in the tray associated with the tray tag (col. 3, lines 32+; col. 4, lines 31 a plurality of tray tags (28), wherein each tray is associated with a tray tag that includes recipient information identifying processing requirements relating to the recipient of the mail items in the tray associated with the tray tag (col. 3, lines 32+; col. 4, lines 31+); and a process management system that is configured to receive processing status information relating to the trays and output the information upon request (col. 4, lines 58+; col. 5, lines 12+), readers (col. 5 lines 5+) such as bar code and emissive tag readers for reading the information from the tray tags (col. 2 lines 51+) and obtaining the process status information by reading information from tray tags (col. 5, lines 5+) for purpose of minimizing the probability that a mailer or the post office will misassemble or misroute a mailing (abstract).

It would have been obvious to one of ordinary skill in the art at the time to

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applicant's invention to have modified Taniguchi to include the tray tag system, as taught by Pintsov and discussed in detail above, for purpose of minimizing the probability that a mailer or the post office will misassemble or misroute a mailing.

Examiner contends that the language added to independent claims 1 and 5 in the amendment dated 5-29-2007 fails to provide any further structural limitation.

Specifically "wherein each mail item includes a remittance to the recipient" is directed to the material worked upon by the system and therefore is not given patentable weight, see MPEP 2115. Furthermore "wherein the mail is processed by a processor for the recipient according to the processing requirements, and wherein the processor receives compensation from the recipient based on the processor's performance with respect to the processing requirements" is functional and fails to provide any structural limitation to the claim. Therefore this language is not given patentable weight, see MPEP 2114.

### ***Allowable Subject Matter***

3. Claims 13-15 and 17-20 are allowed.

### ***Response to Arguments***

4. Applicant's arguments filed 5-29-2007 have been fully considered but they are not persuasive. Applicant has stated that due to the inclusion of previously allowable subject matter in the independent claims that all claims are in condition for allowance. Examiner contends that the claim language indicated as allowable was only in the method claims and inclusion of this language has rendered the method or process

claims (13-15 and 17-20) allowable. Inclusion of this language in the system claims does not however put them in condition for allowance, as it does not provide structural limitation to the claim as necessary in a system claim. This is discussed in more detail in the rejection of claims 1-8 above.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



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